UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/003,822	01/16/87	MASUZAWA K	1705-021-0

OBLON, FISHER, SPIVAK, MC CLELLAND
AND MAIER, CRYSTAL SQUARE FIVE, STE. 400
1755 SOUTH JEFF. DAVIS HWY.
ARLINGTON, VA 22202

EXAMINER	
TORRIP SEED, J	
ART UNIT	**PAPER NUMBER**
129	6

DATE MAILED: 12/23/87

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 9/16/87 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire — month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1 and 3-20 are pending in the application.
   Of the above, claims 3-7 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 1 and 8-20 are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

No additional references are cited.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119, which papers have been placed of record in the file.

Claims 1 and 3-20 are in this case.

Claims 3-7 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a nonelected invention, the requirement having been traversed in Paper No. 4.

The arguments advanced by applicants have been considered but are not found to be persuasive. No cognizant basis is seen in applicants statement that "...specific provisions is set forth in the Patent and Trademark Regulations which allow at minimum a product, process of synthesizing that product and one use of that product to be "presented" (quotation marks added for emphasis) in the same application." An applicant may "present" as many claims to as many inventions as he, or she may wish in a single application. However, the mere presentation of claims to different inventions, namely products, methods of preparation thereof and a use of that product is not considered to be adequate basis for urging that restriction therebetween would be improper especially where it can be shown where the inventions as claimed are independent and distinct. Each of the

methods as claimed in claims 3-7 are independent and distinct from each other since each is directed to a different method of preparation which may be practiced one independently of the others. Note 35 USC 121 and MPEP 802.01.

Applicants appears to imply that claims 3-7 are directed to only one method of preparation and that 37 CFR 1.141(b) would suggest that restriction in the instant application would be improper. No basis is seen in these arguments since as stated above and in the first Office action each of the methods of preparation as grouped is distinct one from the other and further there is no showing by applicants that the methods as claimed are "specifically adapted" for the manufacture of the products of group I. Applicants should not that each of the methods of claims 3-7 may be used to prepare the products disclosed in Culbertson, et al, of record, when the appropriate starting materials are substituted therein and further, the compositions of the instant claims may be prepared by the methods disclosed in Culbertson, et al. where the appropriate starting materials are substituted therein. Therefore 37 CFR 1.141(b) is not seen to support applicants arguments. Applicants' attention is specifically directed to MPEP 806.05(f) which is deemed to be directly in point.

Applicants further urge that MPEP 803 would suggest that the restriction in this case is improper since in applicant's view there "does not appear to be a serious burden on the Examiner" in searching the claims since they" are all contained within the same class and subclass. The mere fact that different inventions are classified in the same class and subclass is not deemed to be adequate basis for urging that a serious burden is not involved in searching each of the inventions in a single application, especially since different consideration are involved in searching each of the different inventions. Further, although a single class and subclass may be listed as the place where the different inventions may be classified, this listing is not the only place where the inventions will be searched. Therefore, a serious burden would be placed on the Examiner to search each of the inventions in a single application.

The restriction requirement is deemed to be proper, is maintained and is herein made FINAL.

Claims 1 and 8-20 are allowable. However, applicants should note that the phrase "alkyl group" is improperly written as one word "alkylgroups" in claim 1, line 7 from the last line. Correction is required.

This application is in condition for allowance except for the presence of claims 3-7 to an invention nonelected with traverse in Paper No. 4.

APPLICANT IS GIVEN 30 DAYS FROM THE DATE OF THIS LETTER TO CANCEL THE NOTED CLAIMS OR TAKE OTHER APPROPRIATE ACTION (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

Any inquiry concerning this communication should be directed to Examiner J.H. Turnipseed at telephone number 703-557-3920.

JHT
Turnipseed:bjk

12/21/87

GLENNON H. HOLLRAH
SUPERVISORY PATENT EXAMINER
ART UNIT 129